

Application No.: 10/525,088

Docket No.: 12810-00032-US

REMARKS

Claims 12-31 are now in the application. Newly presented claim 19 finds basis in the specification at page 20, line 29. Newly presented claims 20-23 and 25-31 find basis in the specification at page 11, lines 26-31; page 13, lines 6-10 and page 15, lines 31-36. Newly presented claim 24 finds basis in the specification at page 22, line 41. The newly presented claims do not introduce any new matter.

Claims 12-18 were rejected under 35 USC 103(a) as being unpatentable over US patent 5,488,117 to Nesvadba. Nesvadba does not render obvious the claimed invention since, in addition to the pH recitation, Nesvadba does teach the specific claimed combination of stabilizers and their amounts.

Nesvadba does not suggest using a mixture of a benzofuranone derivative B, an organic phosphite C and a sterically hindered phenol or aromatic amine D when the polymer is a styrene-diene block copolymer from the myriad of possibilities mentioned therein. Furthermore, nothing in Nesvadba suggests using the relative amounts of these stabilizers that are recited in the claims. Arriving at the claimed invention would require a fortuitous selected of stabilizers from all of the possible combinations alluded to in Nesvadba.

The present invention provides styrene-diene block copolymers having effective resistance to aging at low levels of the stabilizers B, C and D. As illustrated in the Table on page 30 of the specification and discussed at lines 26-29, when only B and C are used as stabilizers (comparative examples 1c to 5c), much higher amounts of B have to be used in order to show a sufficient low crosslinking pressure (page 30, lines 26 to 29 and Table). In other words, when stabilizer "D" is present much smaller amounts of stabilizer "B" can be used to achieve satisfactory results. This is of significance since the benzofuranone stabilizers "B" are the most expensive of the claimed stabilizers.

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The indication of very low amounts of benzofuranone stabilizer in combination with organic phosphate or phosphonite in US 5,488,117 is limited to the use as stabilizers in polyolefins (Col. 17, lines 25 to 44). The stabilization of polyolefins, however, is not as critical as of styrene-diene block copolymers, since polyolefins do not contain remaining unsaturated double bonds in the polymer backbone.

Furthermore, it is surprising that the relatively small amounts of the stabilizers can be used with the claimed block polymers since these polymers include double bonds that render the polymers more susceptible to aging problems.

The mere fact that cited art may be modified in the manner suggested in the Office Action does not make this modification obvious, unless the cited art suggest the desirability of the modification. No such suggestion appears in the cited art in this matter. The Examiner's attention is kindly directed to *In re Lee* 61 USPQ2d 1430 (Fed. Cir. 2002) *In re Dembiczak et al.* 50 USPQ2d. 1614 (Fed. Cir. 1999), *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), *In re Laskowski*, 10 USPQ2d. 1397 (Fed. Cir. 1989) and *In re Fritch*, 23, USPQ2d. 1780 (Fed. Cir. 1992).

In *Dembiczak et al.*, supra, the Court at 1617 stated: "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., *C.R. Bard, Inc., v. M3 Sys., Inc.*, 157 F.3d. 1340, 1352, 48 USPQ2d. 1225, 1232 (Fed. Cir. 1998) (describing 'teaching or suggestion motivation [to combine]' as in 'essential evidentiary component of an obviousness holding'), *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d. 1453, 1459 (Fed. Cir. 1998) ('the Board must identify specifically...the reasons one of ordinary skill in the art would have been motivated to select the references and combine them');".

Also, the cited art lacks the necessary direction or incentive to those of ordinary skill in the art to render the rejection under 35 USC 103 sustainable. The cited art fails to provide the degree of predictability of success of achieving the properties attainable by the present invention

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needed to sustain a rejection under 35 USC 103. See *Diversitech Corp. v. Century Steps, Inc.* 7 USPQ2d 1315 (Fed. Cir. 1988), *In re Mercier*, 185 USPQ 774 (CCPA 1975) and *In re Naylor*, 152 USPQ 106 (CCPA 1966).

Moreover, the properties of the subject matter and improvements which are inherent in the claimed subject matter and disclosed in the specification are to be considered when evaluating the question of obviousness under 35 USC 103. See *Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 USPQ2d. 1923 (Fed. Cir. 1990), *In re Antonie*, 195, USPQ 6 (CCPA 1977), *In re Estes*, 164 USPQ 519 (CCPA 1970), and *In re Papesch*, 137 USPQ 43 (CCPA 1963).

No property can be ignored in determining patentability and comparing the claimed invention to the cited art. Along these lines, see *In re Papesch*, supra, *In re Burt et al*, 148 USPQ 548 (CCPA 1966), *In re Ward*, 141 USPQ 227 (CCPA 1964), and *In re Cescon*, 177 USPQ 264 (CCPA 1973).

Consideration and allowance are therefore respectfully solicited.

In the event that the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 12810-00032-US from which the undersigned is authorized to draw.

Dated: 3-22-06

Respectfully submitted,

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